

Atty Dkt. No.: 10004190-1
USSN: 09/846,058

REMARKS

Claims 28, 29, 31, 35, and 37-45 have been examined. Claims 29, 31, 35, and 37-44 have been allowed. Claims 28 and 45 have been rejected. In view of the following remarks, the Examiner is requested to allow claims 28, 29, 31, 35, and 37-45, the only claims pending in this application.

Claims 28 and 45 have been amended to recite that the rows deposited on a *planar* surface of a substrate each contain a plurality of spatially addressable features containing the chemical moieties and that the rows are deposited lengthwise along the direction having the higher height uniformity. Support for these amendments can be found in the specification, particularly at page 7, lines 1-9, at page 17, lines 7-30, and in Figure 5. No new matter has been added.

Applicants respectfully request reconsideration of the application.

Allowable Subject Matter

The Examiner is thanked for the indicated allowability of Claims 29, 31, 35, and 37-44.

Claim Rejections - 35 USC § 102

Claims 28 and 45 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by US Patent No. 6,720,157 to Indermuhle et al. (hereinafter "Indermuhle"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). To constitute anticipation, the claimed subject matter must be identically disclosed in the prior art. *In re Arkley*, 172 U.S.P.Q. 524 at 526 (C.C.P.A. 1972). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d

Atty Dkt. No.: 10004190-1
USSN: 09/846,058

1565, 18 USPQ2d 101 (Fed. Cir. 1991). To overcome the defense of anticipation, "it is only necessary for the patentee to show some tangible difference between the invention and the prior art." *Del Mar Engineering Lab v. Physio-Tronics, Inc.*, 642 F.2d 1167, 1172, (9th Cir. 1981).

Moreover, an anticipation rejection that is based on inherency must be supported by factual and technical grounds establishing that the inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from the teaching of the cited art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

The rejected claims recite depositing a plurality of addressable features onto a *planar surface*.

The entirety of Indermuhle's disclosure is directed to the use of a "pillar" array i.e. a substrate that contains a series of discrete pillars upon which single chemical moieties are deposited. The substrate surface in Indermuhle is highly irregular and is not a *planar surface*, as required by the rejected claims.

Further, since Indermuhle's disclosure requires that each pillar receives a *single* chemical moiety, Indermuhle does not set forth any method in which a *plurality of addressable features* is deposited onto a planar surface. Indermuhle discloses a method in which a plurality of features is deposited upon a *highly irregular* surface, not a *planar surface*, as required by the rejected claims.

Because Indermuhle fails to disclose any method that includes depositing a plurality of addressable features onto a planar surface, Indermuhle fails to disclose all the elements of the rejected claims. Accordingly, Indermuhle cannot anticipate the rejected claims.

This rejection may be withdrawn on this basis alone.

Furthermore, the Examiner has acknowledged that Indermuhle does not explicitly disclose that the height uniformities of two directions are compared, but asserted that "pictures like figure 5 and 6(i) could not be obtained without at least a visual comparison of the heights in all directions." Office Action at page 5. Therefore, the Examiner concluded that comparison of height uniformities is disclosed inherently in Indermuhle.

Atty Dkt. No.: 10004190-1
USSN: 09/846,058

Applicants submit that the Examiner's conclusion is not a *necessary* conclusion from Indermuhle. Indermuhle discloses that each pillar has an aspect ratio, defined as the ratio of the height H of each pillar to the smallest width W of the pillar. See Column 8, lines 16-30. If all the pillars were machined with the same aspect ratio, there would be no need for a visual comparison of heights in all directions. Further, since Indermuhle's pillar array may be mated with the reservoir of reagents using a robot or other automatic means, or using mating pins or guides, no comparison would be necessary. See, e.g., Column 16, line 66 to Column 17, line 17. As such, there are many ways in which reagents can be deposited onto Indermuhle's pillars that do not involve comparing height uniformities. The mere *possibility* that Indermuhle's method can be done by comparing height uniformities is *not* sufficient to support this rejection, according to current law.

Accordingly, there is no basis for an anticipation rejection based on inherency.

Finally, in an attempt to support this rejection, the Examiner argues that because Indermuhle discloses (in Column 8, second paragraph) a way of characterizing the aspect ratio of a pillar, Indermuhle must be performing the method recited in the rejected claims.

The Applicants note, however, that Indermuhle only uses information on the aspect ratio of a pillar for substrate *fabrication*. Indermuhle does not disclose using this information for depositing a plurality of different chemical moieties in a row on the substrate.

Accordingly, even if the Examiner continues to unreasonably construe Indermuhle's disclosure in col. 8 to mean that Indermuhle somehow produces measurements of height uniformity (which it does not), Indermuhle does not disclose the use of those measurements in the same way as required in the rejected claims.

In other words, Indermuhle's disclosure in Col. 8 is not germane to step (b) of the rejected claims, namely the placing of different chemical moieties in a row on a planar surface of the substrate, where the row is in the direction having higher height uniformity.

Atty Dkt. No.: 10004190-1
USSN: 09/846,058

The Applicants submit that this rejection has been adequately addressed.
Withdrawal of this rejection is respectfully requested.

Atty Dkt. No.: 10004190-1
USSN: 09/846,058

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10004190.

Respectfully submitted,

Date: March 27, 2006

By: 

Richard A. Schwartz
Registration No. 48,105

Date: March 27, 2006

By: 

Bret E. Field
Registration No. 37,620

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

F:\DOCUMENT\AGIL\153 (10004190-1)\Response to OA dated 12 29 05.doc